THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WOJCIECH J. JANISIEWICZ and
LEONARD YOURMAN

_____

Appeal No. 93-4205
Application 07/618,437[1]

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ON BRIEF

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Before RONALD H. SMITH, GRON and ELLIS, **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 2, the only claims pending in the application.

Claims 1 and 2 read as follows:

[1] Application for patent filed November 27, 1990.

1. A biological pure culture of Pseudomonas syringae pv. lachrymans having the distinguishing characteristics of the deposited strain designated as NRRL B-18739.

2. A biocontrol composition comprising: Pseudomonas syringae pv. lachrymans and an agriculturally acceptable excipient.

The references relied on by the examiner are:

Janisiewicz, W.J. "Postharvest Biological Control of Blue Mold on Apples," ***The American Phytopathological Society***, vol. 77, pp. 481-485 (1987).

Janisiewicz, W.J. "Biological Control of Diseases of Fruits," ***Boca Raton: CRC Press***, pp. 153-165 (1988).

Janisiewicz et al, (Janisiewicz), abstract "Biological Control of Postharvest Diseases of Pears with Pseudomonas Syringae pv Lachrymans," ***Phytopatholoy***, vol. 79, no. 10 (1989).

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Janisiewicz. We reverse with respect to claim 1 and affirm with respect to claim 2.

The claimed invention is directed to the microorganism ***Pseudomonas syringae*** pv. ***lachrymans.*** According to the specification, this microorganism, which can be found on apple leaves, is capable of inhibiting rot in Pome fruits by post harvest pathogens such as ***Penicillium expansum*** and ***Botrytis cinerea***. Specification, p. 3, para. 1.

The examiner's rejection is based on the disclosure of the claimed ***Pseudomonas syringae*** pv. ***lachrymans*** strain by Janisiewicz at the annual meeting of the American Phytopathological Society in August of 1989. Answer, paragraph bridging pp. 3-4.

The appellants do not contest that the claimed microorganism was disclosed but, rather, they urge that the abstract does not provide an enabling disclosure. The appellants argue that "[t]he authors disclosed said strains and how they could be used, but there was no disclosure as to how one would obtain the particular microorganisms having the properties required for the activity as described." Brief, p. 6, lines 7-10. We agree, in part.

With respect to claim 1, we point out that it is limited to a biologically pure culture of the ***Pseudomonas syringae*** pv. ***lachrymans*** strain designated NRRL B-18739, which has been deposited at the National Regional Research Center in Peoria, Illinois. However, in view of the examiner's insistence during the prosecution of this application that the teachings in the specification as to the isolation of the claimed strain

would not have enabled one skilled in the art to make and use the present invention,[2] we find his current position[3] to be inconsistent and unsustainable. That is, the examiner cannot on the one hand insist that the appellants' disclosure on how to isolate the claimed strains is not enabling; and on the other, allege that an abstract which merely mentions the isolate by name would have enabled those skilled in the art to make and use the invention described in claim 1. Thus, we reverse the rejection with respect to claim 1.

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[2] See the rejection under § 112, first paragraph, on pp. 3-4 of Paper No. 7, mailed February 25, 1992. According to the examiner, "[t]he specification does not disclose a repeatable process to obtain the microorganism and it is not apparent if the microorganism is readily available to the public." Although not cited by the examiner, these requirements were codified under 37 CFR §§ 1.801- 1.809 (effective date January 1, 1990).

[3] The examiner argues on p. 5 of the Answer that

> the applicants contend that the reference used in the prior art rejection does not make the recited strain of the subject invention available to the public. Examiner disagrees. Surely, applicants do not find their isolation procedure to be beyond one of ordinary skill given the subspecies identity and its single defining ability as disclosed in the prior art reference.

As to the examiner's argument that there is no requirement that non-patent publications provide an enabling disclosure, we find his position, indisputably, erroneous. Answer, p. 5, first complete para. It is well established that an anticipatory reference "must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." ***In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); ***Akzo N.V. v. International Trade Commission***, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986) ("the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public"). As pointed out by the examiner the "mere use of a scientific name and a description of the single characteristic of antagonistic ability is inadequate" for purposes of enablement. Paper No. 7, sentence bridging pp. 2-3.

We note that the examiner refers to two, additional references, Janisiewicz '87 and Janisiewicz '88, which were not included in the statement of the rejection. Purportedly, these references demonstrate that the claimed microorganism

was available to those of ordinary skill in the art at the time the application was filed. However, it is well settled that "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." ***In re Hoch***, 428 F.2d 1341, 1342, n. 3, 166 USPQ 406, 407, n. 3 (CCPA 1970). Accordingly, since these references were not cited as prior art in the rejection, we have not considered, or addressed, the arguments presented by the examiner.

As to claim 2, we do not find that it is limited to a biologically pure culture of a specifically-deposited microorgansim. Rather, the open language of this claim reads on the microorganism as it occurs in its natural state. That is, claim 2 reads on any strain of ***Pseudomonas syringae*** pv. ***lachrymans*** on an apple leaf and water. Thus, unlike the situation with respect to claim 1, there is no requirement that the microorganism be isolated.

Although the issue is not before us, upon return of this application to the corps, the examiner should consider whether

because this claim reads on a product of nature, that it falls within the proper subject matter for patentability. See 35 U.S.C. § 101. There is no required "hand of man" aspect to the invention described in claim 2, nor is there any limitation as to a characteristic or utility not found in the natural habitat of the microorganism. ***Diamond v. Chakrabarty***, 447 U.S. 303 (1980).

Accordingly, the rejection is affirmed, in part.

The decision of the examiner is affirmed, in part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

RONALD H. SMITH Administrative Patent Judge	
TEDDY S. GRON Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
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